

## **REMARKS**

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the above amendments and following remarks.

### **I. STATUS OF THE CLAIMS AND FORMAL MATTERS**

Claims 1-9 are currently pending. Claims 1-9 are rejected. Claim 1 is hereby amended. No new matter has been introduced. Support for this amendment can be found throughout the Application as originally filed.

The amendments to the claims are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicant is entitled.

### **II. THE REJECTION UNDER 35 U.S.C. § 112, Second Paragraph**

Claims 4-6, 8 and 9 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Particularly, with respect to claims 4, 8 and 9, the Examiner maintains that it is unclear “what specific apparatus structure constitutes the recited arrangement that enables the dewaxing function.”

The Examiner still maintains that the specification does not explicitly point out what structure of the treatment apparatus performs the dewaxing. Applicant respectfully submits that

the application provides support for both the dewaxing function and the corresponding structure for performing this function.

We previously recited Paragraph [0034] of the published application to the Examiner, which discloses:

The plate 26 supports an annular arrangement of vessels 28 for the receipt of respective baskets 29 in which there are placed microscope slides (not shown) with tissue specimens which are to be treated in liquid baths in the vessels. **The liquid baths consist of suitable reagents for dewaxing and treatment of the tissue specimens. In the illustrated embodiment, ten such vessels 28 are arranged on the support plate 26.** Further, a loading magazine 30 for vessels to be retreated in the apparatus is placed on the plate. In the illustrated embodiment the loading magazine comprises two stations (station 1 and 2), so that it can receive two baskets at the time.

As per our understanding of paragraph [0034] above, the structure for performing the dewaxing includes ten vessels 28 consisting of suitable reagents, whereby the vessels 28 are arranged on a support plate 26.

On at least this basis, reconsideration and withdrawal of this rejection is, therefore, respectfully requested.

### III. THE REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1, 2, 4, and 8 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,580,056 to Tacha ("*Tacha*") in view of U.S. Patents Nos. 3,800,778 to Lohr et al. ("*Lohr*") and a newly cited internet publication entitled: "GB1 Programmable Temperature Controller" from digitry.com ("*Digitry*").

Also, claims 3, 7, and 9 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Tacha* in view of *Lohr*, *Digitry*, and U.S. Patent No. 6,283,015 to Kwon et al. ("*Kwon*").

Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Tacha, Lohr*, and *Digitry*, in further view of U.S. Patent Nos. 6,017,495 to Ljungmann ("*Ljungmann*") and 6,544,798 to Christensen et al. ("*Christensen*").

#### IV. RESPONSE TO REJECTIONS

Claim 1, as herein amended, recites:

"An apparatus for heat treatment of tissue specimens, comprising a pressure cooker (1) for cooking of the tissue specimens, a temperature sensor (5) and a pressure sensor (6) connected to the pressure cooker, and a control unit (15) for time-controlled heat treatment of the tissue specimens in the pressure cooker (1), the control unit (15) being arranged to control a programmed step-by-step heating course, with a programmed time duration on each temperature step, ... and that **the control unit (15) also is arranged to control a programmed step-by-step cooling course by controlling pressure**, from the chosen maximum temperature down to a chosen final temperature, wherein both the programmed step-by-step heating course and the programmed step-by-step cooling course are controlled by the control unit via a data program. (Emphasis Added)

Regarding claim 1 (above), the Examiner now contends that the heating and cooling process is taught by the *Digitry* publication. Specifically, it is alleged that *Digitry* teaches a programmable temperature controller that can store up to 10 temperature schedules (see *Digitry*; page 3, temperature profile graph).

Applicant respectfully submits that while *Digitry* describes a programmable temperature controller, *Digitry* fails to disclose or suggest "**a programmed step-by-step cooling course by controlling pressure** [,]" as recited in amended claim 1.

Paragraph [0007] of the Applicant's published application discloses that one of the drawbacks of the prior art in programming temperature courses lies in air cooling once a heating element is disconnected. Page 4 of the *Digitry* reference merely indicates that the GB1 device operates with a Type K thermocouple with cold junction compensation and is, therefore, silent as

to disclosing or suggesting “a programmed step-by-step cooling course by controlling pressure.”

Therefore, for at least the reason described above, Applicant submits that claim 1 is patentable over the cited *Taka*, *Lohr*, and *Digitry* references, taken either alone or in combination.

#### IV. DEPENDENT CLAIMS

The other claims are dependent from independent claim 1 and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

#### CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are patentable over the prior art, and an early and favorable consideration thereof is solicited. Because Applicant maintains that all claims are allowable for at least the reasons presented hereinabove, in the interests of brevity, this response does not comment on each and every comment made by the Examiner in the Office Action. This should not be taken as acquiescence of the substance of those comments, and Applicant reserves the right to address such comments

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicant's undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary

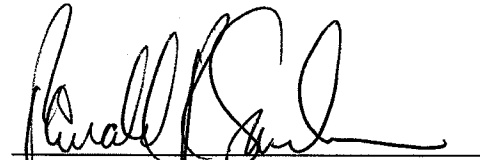
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Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

By:

A handwritten signature in black ink, appearing to read 'Ronald R. Santucci', written over a horizontal line.

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